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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/713,939 | 11/13/2003 | Samuel Zellner | 030392 (BLL-0126) | 4821 |

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Philmore H. Colburn II
Cantor Colburn LLP
55 Griffin Road South
Bloomfield, CT 06002

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| EXAMINER |
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SHEDRICK, CHARLES TERRELL

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| ART UNIT | PAPER NUMBER |
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2687

DATE MAILED: 02/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/713,939 | Applicant(s) ZELLNER, SAMUEL | |
| | Examiner Charles Shedrick | Art Unit 2687 | |

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-19,21-23 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 11/22/05 have been fully considered but they are not persuasive. In the present application, Applicant argues in reference to claims 1,8, and 15 that Urban et al. does not teach or suggest the features of "retrieving information elements stored in a network database associated with an originator terminal...and transmitting a communication including said information elements to recipient terminal.

The examiner respectfully disagrees with Applicant's argument because Urban et al. recites " a calling party retrieves and/or generates a caller ID message" (**Abstract, paragraph 0039**), furthermore Urban et al. recites "Moreover, the Caller ID Messaging menu presented by telecommunications network 710 may be programmed over a variety of mediums, such as, for example, a voice-activated and/or Dual Tone Multi-Frequency (DTMF) menu prompt. The calling party, for example, might select to access stored Caller ID Messaging Signals by entering a "1" on a touch-tone keypad or by speaking into a receiving audio subsystem and stating the word "one." This entry would then prompt the calling party through choices such as accessing recently sent Caller ID Messaging Signals, alphanumeric listings of each receiving party, and so on. After making a selection, the telecommunications network 710 retrieves the stored Caller ID Messaging Signal from the database 719. In addition, the calling party might enter a code (e.g., "*99") in order to automatically block any exchange of Caller ID Messaging Signals. Similarly the calling party could unblock and allow the exchange of Caller ID messaging by entering another code. (**paragraphs 057-0061**)

Claims **1-20** are rejected under 35 U.S.C. 102(e) as being anticipated by **Urban et al. Pub. No. US 2004/0209605**

The applied reference has a common Assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Consider **claim 1**, Urban et al. clearly discloses a method for transmitting enhanced originator information over a communication network (**Abstract**) comprising, retrieving information elements stored in a network database and associated with an originator terminal (**abstract, paragraph 0039,0057**), said retrieving based upon at least one of a service plan (i.e., a subscriber that subscribes to a service)(**paragraph 0046**) and a terminal capability associated with a recipient terminal (**paragraph 0038**); and transmitting a communication including said information elements to said recipient terminal prior to establishing a communication session with said recipient terminal (i.e., the caller ID messaging is transmitted similar to caller ID in which happens prior to the user answer the phone or during a call with call-waiting caller-id)(**paragraphs 0012 and 0052**); Wherein said transmitting is conducted over at least one of : an IP network, a PSTN, a WLAN, a wireless network, a cable network a fiber optic network, a video network, and a satellite network (**paragraphs 0013 and 0045**).

Consider **claim 2 and as applied to claim 1 above**, Urban et al. clearly discloses a method wherein said terminal capability relates to at least one of a: terminal device type including at least one of: a personal computer, a network computer, a wireless mobile telephone, a wireless mobile computer device, a facsimile, a network appliance, and a wire-line telephone, and terminal device technology features including at least one of: binary-based caller-identification feature; and graphical features (**paragraphs 0038,0047, and claim13**).

Consider **claim 3 and as applied to claim 2 above**, Urban et al. clearly discloses a method wherein said information elements includes at least one of: font and character style capabilities; a logo; an image; audio; multi-media; animation; VPIM; a uniform resource locator; a physical location address; video; an alerting tone; and advertising material (**Abstract, paragraph 0050 and claim 16**).

Consider **claim 4 and as applied to claim 1 above**, Urban et al. clearly discloses a method wherein said communication comprises at least one of: Voice; Data; Video; Messaging; Instant Messaging; and Paging (**Paragraphs 0012, 0038,0050**).

Consider **claim 5 and as applied to claim 1 above**, Urban et al. clearly discloses a method wherein said communication including said information elements are generated by said communications network (**paragraphs 0013 and 0045**).

Consider **claim 6 and as applied to claim 1 above**, Urban et al. clearly discloses a method wherein said communication network includes at least one of: a circuit-switched network; a packet-switched network; a wireless network; an asynchronous transfer mode network; and a Multiprotocol Label Switching (MPLS) (**Paragraph 0045**).

Consider **claim 7 and as applied to claim 1 above**, Urban et al. clearly discloses a method wherein said service plans (i.e., subscriber data) are stored in a service profile database (**paragraph 0014**), said plans stored in a dual format operable for accommodating both graphically-enabled caller identification devices and caller identification devices that are not graphically enabled (**paragraphs 0059-0061 and figures 18 –20**).

Consider **claim 8**, Urban et al. clearly discloses a storage medium **216 (figure 2)**, **718 (figures 7-9,15 and 17)**, including a machine- readable computer program code **214 (figure 2)** for transmitting enhanced originator information over a communication network (**paragraphs 0038-0040**), said storage medium including instructions for causing a server to implements a method comprising:

retrieving information elements stored in a network database and associated with an originator terminal (**abstract, paragraph 0039,0057**), said retrieving based upon at least one of a service plan (i.e., a subscriber that subscribes to a service)(**paragraph 0046**) and a terminal capability of a recipient terminal (**paragraph 0038**); and transmitting a communication including said information elements to said recipient terminal prior to establishing a communication session with said recipient terminal (i.e., the caller ID messaging is transmitted similar to caller ID in which happens prior to the user answer the phone or during a call with call-waiting caller-id)(**paragraphs 0012 and 0052**); Wherein said transmitting is conducted over at least one of : an IP network, a PSTN, a WLAN, a wireless network, a cable network a fiber optic network, a video network, and a satellite network (**paragraphs 0013 and 0045**).

Consider **claim 9 and as applied to claim 8 above**, Urban et al. clearly discloses a storage medium wherein said terminal capability relates to at least one of a: terminal device type

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including at least one of: a personal computer, a network computer, a wireless mobile telephone, a wireless mobile computer device, a facsimile, a network appliance, and a wire-line telephone, and terminal device technology features including at least one of: binary-based caller-identification feature; and graphical features (**paragraphs 0038,0047, and claim13**).

Consider **claim 10 and as applied to claim 8 above**, Urban et al. clearly discloses a storage medium wherein said information elements includes at least one of: font and character style capabilities; a logo; an image; audio; multi-media; animation; VPIM; a uniform resource locator; a physical location address; video; an alerting tone; and advertising material (**Abstract, paragraph 0050 and claim 16**).

Consider **claim 11 and as applied to claim 8 above**, Urban et al. clearly discloses a storage medium wherein said communication comprises at least one of: Voice; Data; Video; Messaging; Instant Messaging; and Paging (**Paragraphs 0012, 0038,0050**).

Consider **claim 12 and as applied to claim 8 above**, Urban et al. clearly discloses a storage medium wherein said communication including said information elements are generated by said communications network (**paragraphs 0013 and 0045**).

Consider **claim 13 and as applied to claim 8 above**, Urban et al. clearly discloses a storage medium wherein said communication network includes at least one of: a circuit-switched network; a packet-switched network; a wireless network; an asynchronous transfer mode network; and a Multi-protocol Label Switching (MPLS) (**Paragraph 0045**).

Consider **claim 14 and as applied to claim 8 above**, Urban et al. clearly discloses a storage medium wherein said service plans (i.e., subscriber data) are stored in a service profile database (**paragraph 0014**), said plans stored in a dual format operable for accommodating both

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graphically-enabled caller identification devices and caller identification devices that are not graphically enabled (**paragraphs 0059-0061 and figures 18 –20**).

Consider **claim 15**, Urban et al. clearly discloses a system **100 (figure 1)** for transmitting enhanced originator information over a communication network **120 (figure 1)** comprising:

A caller identification-enabled recipient terminal **130 (figure 1)**, said recipient terminal operating over a communication network via a service provider **750 (figures 7,8,9,and 15)**;

An originator terminal **110 (figure 1)** operating over a communication network **120 (figure 1)** via a service provider (**figures 7,8,9,and 15**);

An network-based originator communications information database **718 (figures 7,8,9,and 15)**;

An originator identification system **200 (figure 1)** by said communications network **120(figure 1)**, said originator identification system performing:

retrieving information elements stored in a network database and associated with an originator terminal (**abstract, paragraph 0039,0057**), said retrieving based upon at least one of a service plan (i.e., a subscriber that subscribes to a service)(**paragraph 0046**) and a terminal capability of a recipient terminal (**paragraph 0038**); and transmitting a communication including said information elements to said recipient terminal prior to establishing a communication session with said recipient terminal (i.e., the caller ID messaging is transmitted similar to caller ID in which happens prior to the user answer the phone or during a call with call-waiting caller-id)(**paragraphs 0012 and 0052**); Wherein said transmitting is conducted over at least one of : an IP network, a PSTN, a WLAN, a wireless network, a cable network a fiber optic network, a video network, and a satellite network (**paragraphs 0013 and 0045**).

Consider **claim 16 and as applied to claim 15 above**, Urban et al. clearly discloses a system comprising a service profile database **719 (figures 7,8,9,and 15)** operable for storing at least one of a services plan (i.e., subscriber) and relates to at least one of a terminal capabilities: said terminal capabilities relating to at least one of a: terminal device type including at least one of: a personal computer, a network computer, a wireless mobile telephone, a wireless mobile computer device, a facsimile, a network appliance, and a wire-line telephone, and terminal device technology features including at least one of: binary-based caller-identification feature; and graphical features (**paragraphs 0038,0047, and claim13**).

Consider **claim 17 and as applied to claim 15 above**, Urban et al. clearly discloses a system wherein said information elements includes at least one of: font and character style capabilities; a logo; an image; audio; multi-media; animation; VPIM; a uniform resource locator; a physical location address; video; an alerting tone; and advertising material (**Abstract, paragraph 0050 and claim 16**).

Consider **claim 18 and as applied to claim 15 above**, Urban et al. clearly discloses a system wherein said communication comprises at least one of: Voice; Data; Video; Messaging; Instant Messaging; and Paging (**Paragraphs 0012, 0038,0050**).

Consider **claim 19 and as applied to claim 15 above**, Urban et al. clearly discloses a system wherein said communication network includes at least one of: a circuit-switched network; a packet-switched network; a wireless network; an asynchronous transfer mode network; and a Multi-protocol Label Switching (MPLS) (**Paragraph 0045**).

Consider **claims 21 and 23 and as applied to the method of claim1 and system of claim 15**, Urban et al. teaches wherein the service plan includes controlling the presentation of

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the communication of the recipient terminal by screening the information elements in the communication based upon at least one of the content and format of the information elements, the screening performed based upon criteria configured by a user of the recipient terminal (i.e., profiles associated with the Caller ID Messaging Signal, including configuration, authenticity, security, and others. In various embodiments, the data may be stored by the communications network, a peripheral storage device connected to the communications network, the Caller ID Messaging Device, and/or other connected networks (**paragraph 0038 and 0055-0061**).

Consider claim 22 and as applied to the storage medium of claim 8, Urban et al., teaches wherein the service plan includes options including controlling presentation of the communication on the recipient terminal by screening the information elements in the communication based upon at least one of content and format of the information elements in the, the screening performed based upon criteria configured by a user of the recipient terminal i.e., profiles associated with the Caller ID Messaging Signal, including configuration, authenticity, security, and others. In various embodiments, the data may be stored by the communications network, a peripheral storage device connected to the communications network, the Caller ID Messaging Device, and/or other connected networks (**paragraph 0038 and 0055-0061**).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

See Koch Pub No.US 20050073999 A1

Simpson US Patent No. 6,771,755 B1

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2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Shedrick whose telephone number is (571)-272-8621.

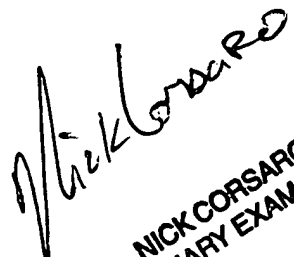
The examiner can normally be reached on Monday thru Friday 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kincaid Lester can be reached on (571)-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Charles Shedrick
AU 2687
January 24, 2006


NICK CORSARO
PRIMARY EXAMINER